

### **Remarks**

In the Office Action dated August 6, 2008, the following objections and rejections are noted: the drawings stand objected to for not showing every feature specified in the claims; claim 1 stands objected to for a grammatical error; claims 1-20 stand rejected under 35 U.S.C. § 112(2) for lack of antecedent basis; claims 1-6, 8-9 and 11-15 stand rejected under 35 U.S.C. § 103(a) over the Wilkerson reference (U.S. Patent No. 7,143,272); claims 7 and 15 stands rejected under 35 U.S.C. § 103(a) over the Wilkerson reference in view of the Chang reference (“Improving Branch Prediction Accuracy by Reducing Pattern History Table Interference”); claims 10 and 16 stand rejected under 35 U.S.C. § 103(a) over the Wilkerson reference in view of the LeFevre reference (US Patent No. 6,854,066); and claims 17-20 stand rejected under 35 U.S.C. § 103(a) over the Wilkerson reference in view of the Kime reference (“Logic and computer design fundamentals”).

Regarding the objection to the drawings, 37 CFR 1.83(a) is directed to claimed features. The definition of a feature is a prominent attribute or aspect of something (*see, e.g.,* <http://wordnet.princeton.edu/perl/webwn?s=feature>). The specific aspect identified as missing in the drawings, while possibly relevant to the claimed invention, is not a prominent attribute or aspect. Rather than limit the cited rule to prominent aspects of the claims, the Examiner appears to require that the figures “detail specific limitations.” Applicant respectfully submits that the detailed, specific limitations of claim 7 should not be interpreted as prominent attributes per 37 CFR 1.83(a). If applied to all cases, such a view would ostensibly require that every applicant replicate the language of each and every claim into the figures. As multitudes of issued patents confirm, Applicant’s position is also supported by a number of US laws, PTO rules and the MPEP, which are briefly discussed as follows:

- Regarding 37 CFR. 1.81(a) see 35 USC §113 and MPEP §601.01(f), which indicate that “applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented.”
- MPEP 608.02(e) clarifies how 37 CFR 1.83(a) should be interpreted and applied: “The drawings are objected to under 37 CFR 1.83(a) because they fail to show [1] as described in the specification. Any structural detail *that*

*is essential for a proper understanding of the disclosed invention should be shown in the drawing.” (emphasis added).*

- MPEP §601.01(f) further indicates that it has been USPTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 USC §113. Since claims in the current application are method claims and the indicated claim language relates to functional aspects of the apparatus, Applicant has complied with MPEP §601.01(f).

Accordingly, Applicant has complied with 37 CFR 1.83(a), that states where the detailed illustration is not essential for a proper understanding of the invention, elements should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (*e.g.*, a labeled rectangular box). As Applicant previously indicated, step 108 is such a labeled rectangular box. Moreover, step 108 relates to a prominent aspect (branch prediction) of which the language of 107 could be considered a subset. The objections are improper and should be removed.

Applicant respectfully traverses the Section 112(2) rejection because the language at issue is at best objectionable. Respectfully, it would be apparent to the skilled artisan that “the branch outcome” refers back to “the conditional branch outcome.” MPEP 2173.05(e) clarifies the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. Here only one branch outcome is recited, thus there can be no confusion that “the branch outcome” refers back to a “conditional branch outcome.” The Examiner has provided no rationale for why the skilled artisan would not be able to reasonable ascertain that the branch outcome refers back to a conditional branch outcome. Notwithstanding, Applicant has made the suggested amendments to facilitate prosecution. Accordingly, Applicant requests that the rejection be withdrawn..

The rejections under 35 USC § 103(a) cannot stand because they rely upon an improper interpretation of system activity. The Examiner’s interpretation of system activity

is improper because it is inconsistent with Applicant's specification. Per MPEP § 2111, the interpretation of pending claims must be consistent with the specification. The Examiner's interpretation encompasses branch history and computation histories. Applicant's specification, however, distinguishes such branch histories from activity monitoring (*see, e.g.*, paragraphs 0006-0014). Thus, an interpretation by the Examiner that includes such histories would be improper because it is inconsistent with Applicant's specification. Applicant's specification states that the system activity is a measurement of how much computation has been done by the system (*see, e.g.*, paragraph 0018). Applicant's specification also provides examples of how to monitor the system activity including supply voltage and/or supply current. These examples would not measure the alleged "system activity" encompassed by the Examiner's cited references. For the aforementioned reasons, the Examiner's interpretation of system activity is improper because it is inconsistent with Applicant's specification. Moreover, under a proper interpretation of system activity, the cited references do not teach correspondence to such system activity. As each of the rejections relies upon the same improper interpretation, the rejections are improper and Applicant requests that they be withdrawn.

Notwithstanding, Applicant would consider amending the claims in an effort to facilitate prosecution if the Examiner were to agree to allowance of such amendments after Final.

Regarding claim 2, Applicant respectfully traverses the Examiner's conclusion that computation history is a running average of previous computation histories. The cited portions do not mention a "running average." It may be that the Examiner is improperly reading "the computational history effectively traces the entire genesis of the current data value in the register" (Wilkerson at col. 5:26-28), to be a running average. Applicant respectfully submits that updates to a register and traces of the genesis of the register are not averages.

In view of the remarks above, Applicant believes that each of the rejections/objections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Aaron Waxler, of NXP Corporation at (408) 474-9068.

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